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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,709	12/10/2003	Gary R. Gillingham	758.1234USC1	2079
23552	7590	07/15/2004		
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			EXAMINER GREENE, JASON M	
			ART UNIT	PAPER NUMBER
			1724	

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/732,709	Applicant(s) GILLINGHAM ET AL.	
	Examiner Jason M. Greene	Art Unit 1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-99 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-99 is/are rejected.
- 7) ☒ Claim(s) 35-63 and 68-96 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/1/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because pages 51-53 of the Specification have been written on in landscape orientation rather than in portrait orientation. See 37 CFR 1.52(a)(iii). Appropriate correction is required.

Claim Objections

2. Claims 35-63 and 68-96 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 35-63 are all directly or indirectly dependent on claim 33. However, while claim 33 is directed toward a method for filtering air in a gas turbine intake system, claims 35-63 are directed toward "The composition" of a previous claim. Claims 68-96 are all directly or indirectly dependent on claim 67. However, while claim 67 is directed toward a method for filtering air in a gas turbine intake system, claims 68-96 are directed toward "The composition" of a previous claim. Therefore, it is not clear whether or not the claims include all of the limitations of the previous claims from which they depend. For

examination purposes, all of the claims were assumed to include all of the limitations of the claims from which they depend.

Claims

3. With regard to claim 1, the Examiner suggests Applicants delete the phrase "and construction" in line 5 to improve the readability of the claim language.
4. With regard to claim 8, the Examiner suggests Applicants insert the word "composition" after the word "monomer" in line 2 to improve the readability of the claim language.
5. With regard to claim 33, the Examiner suggest Applicants insert a period at the end of line 13 to correct a minor grammatical informality.
6. With regard to claims 8, 39, 40, 72, and 73, the phrase "the nylon copolymer" in line 1 has been interpreted as meaning that the polymer is a copolymer of two or more different nylons. If this interpretation is correct, the Examiner suggests Applicants amend the claims accordingly.
7. With regard to claims 16, 47, 49, 80, and 82, the phrase "the resin" in line 1 has been interpreted as being the additive combined with the polymer. If this interpretation is

correct, the Examiner suggests Applicants replace the phrase with "the additive" to preserve consistency of terminology.

8. With regard to claims 20, 51, and 84 the phrase "the resinous additive" in lines 1-2 has been interpreted to mean that the additive comprises a blend of a resinous additive and a fluoropolymer.

9. Claim 63 recites the limitation "the polyarylate polymer" in line 1. However, claim 29, from which claim 63 depends, does not recite the polymer being a polyarylate polymer. It appears as though claim 63 should be dependent upon claim 62. For examination purposes, claim 63 has been assumed to depend upon claim 62. If this assumption is correct, the Examiner suggests Applicants amend the claim accordingly.

10. Claims 65 and 98 recite the limitation "said step of directing air into an air intake of a gas turbine system having a plurality of filter element pairs" in lines 1-2. However, claims 33 and 67, from which the claims depend, do not recite the methods comprising a step of directing air into an air intake of a gas turbine system having a plurality of filter element pairs. It appears as though claims 65 and 98 should be dependent upon claims 64 and 97, respectively. For examination purposes, claims 65 and 98 have been assumed to depend upon claims 64 and 97, respectively. If this assumption is correct, the Examiner suggests Applicants amend the claim accordingly.

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11. Claims 66 and 99 recite the limitation "the filter element pairs" in line 2.

However, claims 33 and 67, from which the claims depend, do not recite the methods including filter element pairs. It appears as though claims 65 and 98 should be dependent upon claims 64 and 97, respectively. For examination purposes, claims 65 and 98 have been assumed to depend upon claims 64 and 97, respectively. If this assumption is correct, the Examiner suggests Applicants amend the claim accordingly.

12. Claim 96 recites the limitation "the polyarylate polymer" in line 1. However, claim 29, from which claim 96 depends, does not recite the polymer being a polyarylate polymer. It appears as though claim 96 should be dependent upon claim 95. For examination purposes, claim 96 has been assumed to depend upon claim 95. If this assumption is correct, the Examiner suggests Applicants amend the claim accordingly.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is directed to a filter structure for filtering air in a gas turbine intake system. However, claim 3 also recites the method step of directing the air through the media pack of the filter element and into the open filter interior to clean the air. Since claim 3 is an apparatus claim, it is not clear how the method step recited in claim 3 would further define the apparatus recited in claim 3.

Double Patenting

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. Claims 1-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of

compending Application No. 09/871,169. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 1-32 of the instant application are identical to claims 1-32 of the '169 application except that instant claim 1 recites a specific air demand for the gas turbine and omits the specific operating temperature. However, since one of ordinary skill in the art would recognize that the size of the filter structure of claim 1 of the '169 application could be adjusted to accommodate gas turbines having different air demands, it would have been obvious to one of ordinary skill to design the filter structure of '169 application for use in a gas turbine air intake system having an air demand greater than 8000 ft³/min. Additionally, one of ordinary skill in the art would recognize the need to design the filter structure of the instant application to withstand operating conditions associated with a gas turbine operating at 140⁰F to 350⁰F.

The Examiner notes that the filter structures of instant claim 1 and claim 1 of the '169 application are not necessarily identical because the sizes of the filter structures will vary depending upon the air intake air demand of the particular gas turbine.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

18. Claims 33-66 and 67-99 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 33-66 and 67-99, respectively, of compending Application No. 09/871,169. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 33-99 of the instant application are identical to claims 33-99 of the '169 application except that instant claims 33 and 67 recite a specific air demand for the gas turbine and omit the specific operating temperature. However, since one of ordinary skill in the art would recognize that the size of the filter of claims 33 and 67 of the '169 application could be adjusted to accommodate gas turbines having different air demands, it would have been obvious to one of ordinary skill to design the filter of the '169 application for use in a gas turbine air intake system having an air demand greater than 8000 ft³/min. Additionally, one of ordinary skill in the art would recognize the need to design the filter of the instant application to withstand operating conditions associated with a gas turbine operating at 140°F to 350°F.

The Examiner notes that the filters of instant claims 33 and 67 and claims 33 and 67 of the '169 application are not necessarily identical because the sizes of the filter structures will vary depending upon the air intake air demand of the particular gas turbine.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Greene whose telephone number is (571)

272-1157. The examiner can normally be reached on Monday - Friday (9:00 AM to 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

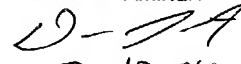
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason M. Greene
Examiner
Art Unit 1724



jmg
July 8, 2004

DUANE SMITH
PRIMARY EXAMINER


7-12-04